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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,086	04/08/2004	Walter R. Miranda	6570/91729	8979

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EXAMINER

NEWTON, JARED W

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/821,086	Applicant(s) MIRANDA ET AL.	
	Examiner Jared W. Newton	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-20 and 22-31 is/are rejected.
- 7) ☒ Claim(s) 21, 26, 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final rejection is in reply to the remarks filed March 13, 2006, by which claims 13-31 were added, and claims 1-12 were cancelled.

Claim Objections

Claim 26 is objected to because of the following informalities:

Claim 26 should read as follows, wherein ~~striketrough~~ items should be removed, and underlined items should be added, so as to better clarify the metes and bounds of the claim:

--The display as in claim 13, a first one of the two arms comprising a first uppermost portion on the said first side of the cradle; a second one of the two arms comprising a second uppermost portion on the said first side of the cradle; the first trough comprising a lowermost portion;
a first projection being a projection on a horizontal plane of a straight line through the first uppermost portion and the lowermost portion; a second projection being a projection on the horizontal plane of a straight line through the second uppermost portion and the lowermost portion;

wherein said first and second projections ~~necessarily~~ intersect at an angle greater than 0° and less than 180°; ~~the first projection being a projection on a horizontal plane of a straight line through the first uppermost portion and the lowermost portion; the second projection being a projection on the horizontal~~

~~plane of a straight line through the second uppermost portion and the lowermost portion .--~~

Claim 26 is further objected to for being indefinite because the projection of any two lines on a horizontal plane, except for parallel lines, will intersect between 0 and 180 degrees.

Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim, or a dependent claim) is considered indefinite, since the resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not

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required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 26 recites the broad recitation "greater than 0° and less than 180°" (see Line 8, and then claim 27, which depends on claim 26, recites "between about 90° and 120°" (see Lines 2-3), which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. Des. 483,427 to Lim.

Please see Examiner's Figures 1E and 2E below for reference.

Lim discloses a golf club organization device 9 comprising: a support member 6; a cradle 5; the cradle comprising two arms 1 and 2; two arms being separated from one another by a first trough 3 on a first side the cradle; the two arms being separated from one another by a second trough 4 on a second side of the cradle; the cradle being movable between a first orientation and a second orientation relative to the support member 6,7; the cradle configured for supporting and displaying a golf club, with a shaft downwardly from the cradle, said golf club capable of resting against the first side of the cradle when the cradle is in the first orientation and against the second side of the cradle when the cradle is in the second orientation.

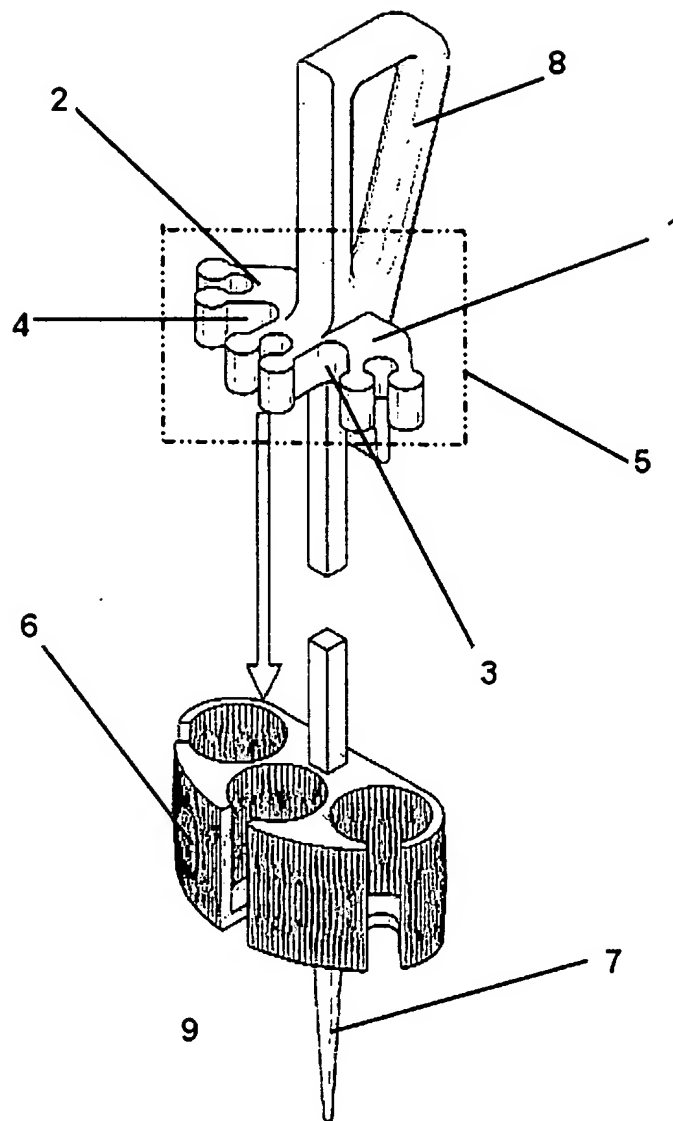


Figure 1E.

Lim further discloses said arms being mirror images of each other along axis A, as well as the first and second sides of the cradle being mirror images of each other along axis A (see FIG. 2E).

Lim further discloses a third central arm comprising an intermediate peak formed from the first and second sides of the cradle (see FIG. 6, Lim).

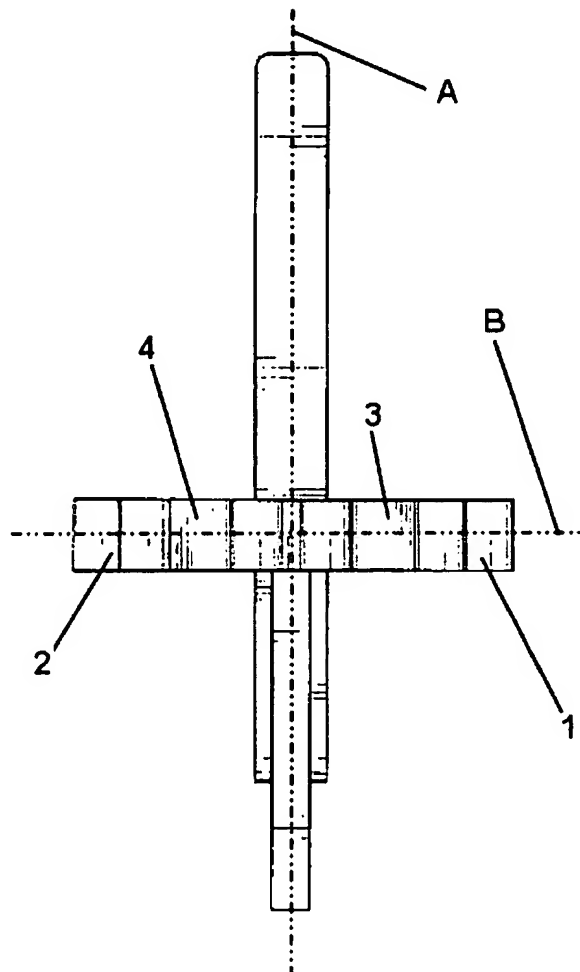


Figure 2E.

Lim further shows both the first and second sides of said cradle as capable of supporting either a left-handed or a right-handed golf club (see FIG. 6, Lim).

Lim further shows the two arms being curved on each of the first and second sides on the cradle (see FIG. 6, Lim)

Claims 13, 14, 16, 20, and 22-31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,085,901 to Lin.

Lin discloses a golf club mount comprising: a support member 2; a cradle 4; the cradle comprising two arms; said two arms being separated from one another by a first upper trough (shown at 43 in FIG. 2) on a first side the cradle; the two arms being separated from one another by a second lower trough (shown at 41 in FIG. 2) on a second side of the cradle; the cradle being movable between a first orientation and a second orientation relative to the support member; the cradle configured for supporting and displaying a golf club, with a shaft downwardly from the cradle, said golf club resting against the first upper side of the cradle when the cradle is in the first orientation and against the second lower side of the cradle when the cradle is in the second orientation (see FIGS. 4A and 4B).

Lin further discloses said arms being mirror images of each other about a vertical axis (see FIG. 2).

Lin further shows said both said first upper and second lower sides of said cradle as capable of supporting a left-handed or a right-handed golf club.

Lin further shows said support member 2 comprising a rod, said rod received through a bore 44 in said cradle; the cradle being pivotal about the rod for switching between first and second positions (see FIG. 4A).

Lin further shows a plurality of cradles mounted on the rod, and independently movable (see FIG. 2).

Lin further shows said arms being curved on both the first upper and second lower sides of the cradle (see FIG. 2).

Insomuch as understood in view of the claim objections above, in regard to claim 26, as shown by Lin, the intersection of a first and second line, wherein the first line crosses through an uppermost point on a first side of said cradle and a lowermost point at the first trough, and further wherein the second line crosses through a second uppermost point on a first side of said cradle and said lowermost point, would form an angle between 0 and 180 degrees when projected on a horizontal plane.

Lin further shows said mount comprising a bracket 6, a plurality of support members 7 being mounted on said bracket, and said bracket capable of being mounted on a structural member (see FIG. 5).

In regard to claims 30 and 31, Lin shows the mount as set forth above comprising a cradle means 4, and a supporting, rotating, and mounting means 2,3 (see FIG. 2).

Claim Rejections - 35 USC § 103

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over '427 to Lim in view of US Patent No. 4,086,678 to Torr.

Lim discloses the limitations of claim 13 as set forth above. Lim does not disclose one of said arms comprising a plurality of ribs extending from a spine.

Torr sets forth a golf club cleaning tool 10 attachable to various surfaces such as a golf bag 30, said tool comprising a plurality of ribs extending from a spine (see FIG. 3).

The Lim and Torr references are analogous art because they are from the same field of endeavor—golf club accessories. It would have been obvious to one of ordinary skill in the art at the time of the invention to attach the tool as disclosed by Torr to the device as disclosed by Lim, in order to provide said device with a means of cleaning the golf clubs it supports. Lim sets forth a golf club organizer capable of being inserted into the ground. Torr discloses a cleaning tool for removing dirt from a golf club, and the desirability of having said tool attached to a club storage device for easy cleaning of the clubs stored within the device. The obvious successful inclusion of the tool to Torr on the device to Lim follows, providing said device with a convenient and easily accessible cleaning means.

Allowable Subject Matter

Claims 21 and 27, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further rewritten to overcome the Claim Objections and rejections base on 35 USC 112 as set forth above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

With respect to recitation regarding said display being configured to support a specific type of golf club in a specific manner, it is noted that since this recitation is functionally reciting specific unclaimed elements (golf clubs), a reference need not explicitly show use with those elements in the exact manner described. Rather, a reference need only *be capable* of being used in such a way as claimed. In the Remarks filed March 13, 2006, the Applicant traverses the Lin reference citing, "the Lin mount 4 (that the Office Action characterized as the claimed cradle) is rotated to anchor the golf club shafts and to prevent them from shifting and scraping other golf club shafts" (see Page 9, Lines 11-13). The above assertion is a correct interpretation of the intended use of the device to Lin; however, that is not to say that the cradle 4 to Lin, as shown in Figure 4A, is not capable of rotating from the position shown, ninety degrees counterclockwise to a second position, both of said positions capable of supporting a golf club head. See MPEP §2105—A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The intended use of the present invention, as described in the claims, does not produce a structural difference over the Lin reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jared W. Newton
April 20, 2006
JWN



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SUPERVISORY PATENT EXAMINER